UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE INTEGRATION GROUP OF AMERICAS, INC.

Petitioner

v.

SITEPRO, INC.,

Patent Owner

Case No. IPR2024-00742

U.S. Patent No. 11,294,403

JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. 42.72, 42.74

I. INTRODUCTION

On July 30, 2024, Petitioner The Integration Group of Americas, Inc. ("Petitioner") and Patent Owner SitePro, Inc. ("Patent Owner") entered into an agreement that resolves all underlying disputes between the parties, including the above-captioned *inter partes* review. The Board authorized the parties to file a joint motion to terminate the review in an email dated August 2, 2024. Accordingly, pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, 42.74, the parties jointly move to terminate the review.

II. BACKGROUND

On April 15, 2024, Petitioner filed a request for *Inter Partes* Review of the claims of U.S. Patent No. 11,294,403. See IPR2024-00742, Paper No. 2. On the same day, Petitioner also filed requests for *Inter Partes* Review of the following additional patents and claims:

- Petitioner filed a request for *Inter Partes* Review of the claims of U.S. Patent No. 8,649,909. See IPR2024-00724, Paper No. 2.
- Petitioner filed a request for *Inter Partes* Review of the claims of U.S. Patent No. 11,175,680. See IPR2024-00737, Paper No. 2.
- Petitioner filed a request for Inter Partes Review of the claims of U.S. Patent No. 9,342,078. See IPR2024-00738, Paper No. 2.
- Petitioner filed a request for *Inter Partes* Review of the claims of U.S. Patent No. 9,898,014. See IPR2024-00739, Paper No. 2.

- Petitioner filed a request for *Inter Partes* Review of the claims of U.S. Patent No. 11,7266,504. See IPR2024-00740, Paper No. 2.

- Petitioner filed a request for *Inter Partes* Review of the claims of U.S. Patent No. 10,488,871. See IPR2024-00741, Paper No. 2.

Patent Owner has yet to file any Preliminary Responses, which are due no later than August 24, 2024 for IPR2024-00740, and August 20, 2024 for the remaining proceedings identified above.

III. THE AGREEMENT

The parties have entered into a Settlement Agreement (the "Agreement") that has settled their dispute involving U.S. Patent No. 11,249,403 ("the '403 patent"). Pursuant to 37 C.F.R. § 42.74(b), the Agreement is filed separately and concurrently with this motion, as Exhibit 1009, along with a request to treat the agreement as business confidential information under 37 C.F.R. § 42.74(c). The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b).

As part of the Agreement, the parties have stipulated to dismiss, with prejudice, the only district court litigation between the parties involving the '403 patent, *SitePro, Inc. v. WaterBridge Resources, LLC, WaterBridge Operating, LLC,*

WaterBridge Holdings, LLC, WaterBridge Management, Inc., and the Integration Group of the Americas, C.A. and all proceedings currently pending before the Patent Trial and Appeal Board. There are no other related proceedings between the parties here or abroad.

IV. LEGAL STANDARD

35 U.S.C. § 317(a) provides that "[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner unless the Office has decided the merits of the proceeding before the request for termination is filed." 37 C.F.R. § 42.72 similarly provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a)." The Trial Practice Guide also observes that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding" and that the Board "expects that a proceeding will terminate after the filing of a settlement agreement unless the Board has already decided the merits of the proceeding." 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

V. GOOD CAUSE EXISTS TO TERMINATE THIS PROCEEDING

Termination of this review during this stage of the proceedings in view of the Agreement is appropriate. The Agreement ends all patent disputes between the

parties, including this proceeding because the Board has not yet "decided the merits of the proceeding." 77 Fed. Reg. 48755, 48768 (Aug. 14, 2022).

Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit also places a particularly strong emphasis on settlement. For example, it endorses the ability of parties to agree to never challenge validity as part of a settlement. *See Flex-Foot, Inc. v. CRP, Inc.*, 238 F.3d 1362, 1370 (Fed. Cir. 2001); *see also Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties).

Maintaining this review after Petitioner's settlement with Patent Owner would discourage future settlements by removing a primary motivation for settlement: eliminating litigation risk by resolving the parties' disputes and ending the pending proceedings between them. For patent owners, litigation risks include the potential for their patents to be invalidated. If a patent owner knows that an *inter partes* review

is likely to continue regardless of settlement, it can create a strong disincentive for the patent owner to settle.

VI. CONCLUSION

For the foregoing reasons, the Petitioner and the Patent Owner jointly and respectfully request that the Board grant the parties' Joint Motion and terminate this proceeding. The parties also request that the Board grant the parties' joint request to treat the Agreement as business confidential information and keep it separate from the publicly available file of the '403 patent and this *inter partes* review proceeding.

Respectfully submitted,

Date: August 2, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(4) and 42.105, lead counsel for Petitioner hereby certifies that on August 2, 2024, copies of this Joint Motion to Terminate Proceeding were sent via electronic mail to the correspondence address of record for the '403 Patent:

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